

REMARKS

The Office Action indicated that Claims 9-12 and 23-26 were allowed but rejected the subject matter of Claims 15-22 as being unpatentable over the *Abeerg* Publication WO 00/55717 in view of the *Werkhoven* Publication WO 99/59097 when further taken in view of the *Tomita et al.* Japanese Publication 09-167188.

Additionally, Claims 27 and 28-30 were rejected over the *Junichi* Japanese Publication 10-308810 in view of the *Werkhoven* disclosure.

Applicant has amended independent Claims 15, 19, 27 and 28 which are believed to place the case in condition for allowance.

The present invention provides an economical and efficient manner of utilizing limited resources of a miniature display screen in a hand held device as shown, for example, in Figure 5 and disclosed in our specification at Page 14, Line 18 through Page 16, Line 3. As can be seen, a highlighted item, such as a name in a phone directory, can be selected by a user. Thus, our control unit can detect when the screen 511 is being displayed in Figure 5 and when a predetermined time period has elapsed with the highlighted items and the control unit can then retrieve corresponding registration content and superimpose it as a pop-up display over the other potential setting items as shown in the display of 512 in Figure 5. The present invention provides a convenient manner in which a user can access information and enable the initiation of a call to a highlighted name and number as shown in item 513 in Figure 5 in a limited display space.

These features are now set forth in our amended independent claims, such as shown in Claim 15 that defines a control unit measuring a time period from when the selected setting unit is selected according to an instruction inserted into the operation unit and when the measured

length of time exceeds a predetermined length of time, the control unit can control the display to display a setting value of the selected setting items on a part of the display that is overlaid in an area in which the plurality of setting items are being displayed. As shown in Figure 5, 512, the highlighted selected item can then be immediately supplemented with information overlaid on the non-selected plurality of setting items. Giving the limited resources of display area, our present invention not only efficiently activates an operation based upon a highlighted setting item, but provides it in a modified display format that can be readily understood by the user.

When our present invention measures the time period from when a setting item has been selected or highlighted, it is capable of judging whether or not to display the setting value of the selected or highlighted setting item. In other words, the setting value is displayed if the predetermined time elapses and is not displayed if the cursor is moved to cancel the selection or the highlighting before the predetermined time elapses.

It should be noted that by measuring a time period from when the setting item is selected or highlighted an efficient operability by the user can be achieved. For example, suppose a setting value is displayed as soon as the setting item was selected or highlighted, then whenever a cursor moved over a setting item, the setting value of the particular setting item would be displayed and a scrolling movement would consecutively set each of the scrolled setting values to be displayed, one after the other. Needless to say, this would not be efficient and would create a difficulty for the user to find the desired setting item and to receive usable information. Thus, a predetermined time period is provided in the present invention, which is a time period that is longer than the normal time taken for the user to comprehend and move the cursor to a setting item at a next position and the display is formatted in consideration of the functional operability of a limited display screen.

The Office Action cited the *Abeerg* reference to teach a communication terminal having a display that displays a plurality of setting items for related internal functions. The *Abeerg* reference, however, is directed at providing a hierarchical menu system that was stored in a memory and a controller that was capable of presenting individual menus and menu items on a display. Basically, the *Abeerg* reference was teaching the concept of a dynamic menu which could be customized by a user. That is, the user could add and delete menu items on his mobile telephone.

The actual entering of a particular menu or exiting from a particular menu is done by activation of a specific key on a key pad provided on the phone, see Page 9, lines 30-35. *Abeerg* does not recognize nor support any teaching that would resolve a problem of multiple hand entries by a user nor does it set forth time periods that will automatically create various functions and menu displays and provide them in a convenient manner highlighted or titled by, for example, the selected item with the related information overlaid on the same display screen.

The *Werkhoven* reference sought to provide pop-up advertisements related to content being viewed by a user on a computer display. The Office Action contended that the *Werkhoven's* control unit was operable to measure a length of time and display information in a pop-up window when the measured length of time exceeds a predetermined time period. The *Werkhoven's* disclosure, however, is not designed to serve the purpose or convenience of the user nor to eliminate the number of key strokes or input control operations required on a user. Rather, it taught loading a playlist on a web page opened by the user and to independently insert advertisements successively in accordance with the playlist and pop-up windows. A particular pop-up window could be automatically replaced with the next pop-up window when a

predetermined length of time would elapse, as shown graphically in the program flow chart of Figure 1.

Thus, the teaching of Werkhoven is to provide a predetermined time period to be measured from when a pop-up window of an advertisement is being played, such as shown as element 6 in Figure 1 and then automatically initiate the loading of a subsequent advertisement. The user is subject to being controlled by an undesirable advertisement program that ensures that the user will view an advertisement for a certain time period. Additionally, the actual information that is displayed, after the predetermined time passes, is only related to information displayed and reviewed from a web site by the user, before the predetermined time passes in that both are predetermined and included in the playlist.

In contrast, the present invention measures time from when the setting item is selected or highlighted by a user and desirable reference setting values are then displayed after a predetermined time elapses and are not displayed if the cursor is moved to cancel the selection. The setting values additionally can be positioned to be titled by the selected setting item.

The *Tomita et al.* reference is basically an electronic manual to assist a nurse to have a list of potential ailments that could occur at different locations on the body. As can be seen from the Abstract, the contemplated user entry is a stylus pen that the operator taps on the screen diagram. The diagram represents certain entry points associated with the human anatomy. Apparently, a portion of the body can be tapped, such as the shoulder, and as a direct result of the entry or tapping by the user, immediately a pop-up list showing a degree of apparent pain, e.g. heavy or light, is provided.

Again, the pen is utilized to press the display and presumably the potential ailments would then be listed that would fall under the category of the degree of pain.

As can be readily appreciated, there is no teaching or suggesting of measuring predetermined time periods, nor is the display screen limited since obviously various menu options on the front and back of a human figure is shown on a portable computer terminal, presumably like a laptop computer.

There is a requirement in a motivation-suggestion-teaching test to determine whether the combined prior art teachings would have suggested to a person of ordinary skill in the art how to solve the problem addressed by the outstanding claims. Thus, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Abeerg teaches a mobile telephone with a hierarchy menu system stored in a phone memory, that permits the user to input on controlled keys to customize a desired menu. The *Werkhoven* reference provides a computer program that can monitor user activity, download a load core source and playlist, and then cause pop-up advertisements to be imposed on the viewer's computer screen.

Finally, the *Tomita et al.* reference discloses basically a laptop computer capable of disclosing a pair of diagrams of the front and back of the human body, wherein a stylus pen can be utilized to tap selected areas of the screen, as user inputs to secure a medical diagnostic suggestion.

The Federal Circuit has held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination *in the manner claimed.*" (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)

("In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*." (emphasis added)).

It is respectfully submitted that our presently amended claims more than adequately define an invention and none of the references alone or in combination recognize or suggest a solution to the problem in the manner defined by these claims.

Junichi (Japanese Laid-Open Application 10-308810) was cited for combination with the *Werkhoven* reference. This reference was directed to eliminating the necessity of memorizing a phone number by storing the number in the phone with a unique ID, wherein the telephone number can be searched and dialed with a minimal operating procedure. The activation relies upon an input key or a touch panel where the user actually touches the panel in a cell phone which can extract the initial information and memorize it in a storage section and the telephone number and identifier information from which it can be retrieved.

As shown in Figure 3, the identifier information can be related, for example to apparently the initials of a person, or at least two letters and when those letters are chosen with a cursor or other input by the user, the telephone number of those letters and an identification of the person is then disclosed. See Paragraph 0025.

As disclosed in Paragraph 0027, the telephone number concerned could then be dialed by a predetermined keystroke into the information input section of Figure 3. It is not seen how the *Werkhoven* pop-up advertisement measurement of time could be coordinated with the ID information of *Junichi* and certainly, the ability to provide a large number of characters or setting

values that can be utilized in a display, by overlaying an area in which the plurality of setting items are being displayed, is not taught nor suggested by either *Werkhoven* or *Junichi*.

As can be appreciated, with the display arrangement as shown for example, in our drawings, the user can still recognize the setting item and its correlation with the setting values as a result of the overlaying display.

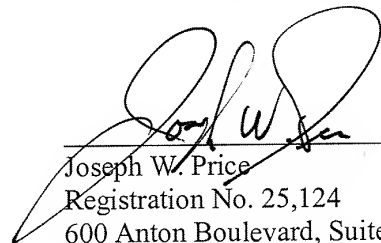
The newly drafted Claims 31 and 32 also disclose the display feature while not obscuring the selected setting item.

It is believed that all of the claims in the present case are now allowable, and an early notification of the same is requested.

If the Examiner believes a telephone interview will help further the prosecution of this case, it is respectfully requested he contact the undersigned attorney at the listed phone number.

Very truly yours,

SNELL & WILMER L.L.P.



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